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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,968	11/14/2003	Michael Neudeck	NEUDECK	3172
20151	7590	04/22/2005	EXAMINER	
HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			BARNES, CRYSTAL J	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/713,968	NEUDECK, MICHAEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Crystal J. Barnes	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 1-9 are pending in this application.

### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a method for automatically configuring a parameterizing surface for parameterizing a controller for a machine, in particular a machine tool or a production machine, are classified in class 700, subclass 96.
  - II. Claims 6-9, drawn to a data network for connecting machine components of a machine, in particular a machine tool or a production machine, are classified in class 709, subclass 217.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with

another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the data network as claimed can be used in a process for connecting machine components to facilitate supervisory control of plural components and machines.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Henry M. Feiereisen, Reg. No. 31,084 on 18 April 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5. Applicant in replying to this Office action must make affirmation of this election. Claims 6-9 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Priority*

7. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the

explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation a machine, and the claim also recites in particular a machine tool or a production machine which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Pub. No. 2003/0069960 A1 to Symons et al.

As per claim 1, the Symons et al. reference discloses a method for automatically configuring a parameterizing surface for parameterizing a controller for a machine, in particular a machine tool or a production machine, comprising the steps of: a) automatically identifying at startup (see page 3 [0025], "configuration agent 230") of the machine ("physical environment 250") currently connected machine components (see page 2 [0022], "computer system 100, peripheral device 110") via a data network (see page 2 [0024], "switched network") which connects the machine components ("computer system 100, peripheral device 110") with each other, b) automatically identifying a structure ("configuration agent 230") of the data network ("switched network") to determine an actual machine topology (see page 3 [0025], "current network infrastructure description"), c) comparing ("management system 200") the actual machine topology ("current network infrastructure description") with stored desired machine topologies ("expected network infrastructure"), and d) if the actual machine topology ("current network

infrastructure description") does not match one of the stored desired machine topologies ("expected network infrastructure"), generating from the determined actual machine topology ("current network infrastructure description") a dedicated parameterizing surface (see page 3 [0025, 0026], "database 210") that is configured for the actual machine topology ("current network infrastructure description"), and e) for parameterizing the controller ("management system 200"), displaying to a user (see page 3 [0026], "data center operator") only parameters (see page 4 [0037], "list B") and/or functions (see page 4 [0034, 0041], "lists C, A") of the identified machine components ("computer system 100, peripheral device 110").

As per claim 2, the Symons et al. reference discloses after performing step b) and c), requiring confirmation (see page 3 [0026], "verify") of the identified actual machine topology ("current network infrastructure description") by the user ("data center operator") before continuing with step d).

As per claim 3, the Symons et al. reference discloses further comprising the step of automatically pre-assigning values (see page 3 [0025], "configuration information") to the parameters (see page 4 [0037], "hardware, firmware, software configuration changes") of the identified machine components ("network



devices"), wherein the pre-assigned values ("configuration information") can be subsequently changed (see page 3 [0025], "changed") by the user ("data center operator") through the parameterizing surface ("database 210").

*Claim Rejections - 35 USC § 103*

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2003/0069960 A1 to Symons et al. in view of US Pub. No. 2003/0064806 A1 to Gordon et al.

As per claim 4, the Symons et al. reference does not expressly disclose further comprising the step of assigning an ID number to each currently connected machine component for automatically identifying the currently connected machine components.

The Gordon et al. reference discloses

(see page 1 [0006], "... interconnection of both internal and external machine components. Each component is assigned a "Globally Unique Identification Number (GUIN) which positively identifies that component, sub-assembly, or game.")

(see page 2 [0022], "Each component bears a globally unique identification number ... ")

(see page 3 [0035], "Address generation device 310 ... GUIN which identifies component/sub-system 300 to the world.")

(see page 4 [0040], "In addition to being individually controlled ... each internal machine component has a pre-programmed, globally unique identification number (GUIN) built in.")

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the network devices of the physical environment taught by the Symons et al. reference with the gaming machine taught by the Gordon et al. reference to include the interconnected components, sub-assemblies and sub-systems.

One of ordinary skill in the art would have been motivated to modify the network devices of the physical environment with the gaming machine taught to include the interconnected components, sub-assemblies and sub-systems to provide

a globally unique identification number for each component that allows a controller to recognize, enumerate and authenticate the devices.

*Allowable Subject Matter*

15. Claim 5 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter:

As per claim 5, the prior art of record taken alone or in combination fails to teach the ID number includes data of the corresponding machine component, said data selected from the group consisting of serial number, order number, software version, machine version, manufacturer identification, manufacturer name and performance data, especially in view of applicant's use of phrase "selected from the group consisting of".

*Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to remote monitoring of network devices and components in general:

USPN 6,735,548 B1 to Huang et al.

USPN 6,225,999 B1 to Jain et al.

USPN 6,205,122 B1 to Sharon et al.

USPN 5,958,012 to Battat et al.

USPN 5,737,319 to Croslin et al.

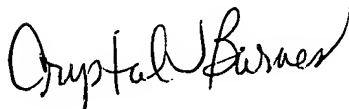
US Pub. No. 2004/0061701 A1 to Arquie et al.

US Pub. No. 2001/0034567 A1 to Allen et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal J. Barnes whose telephone number is 571.272.3679. The examiner can normally be reached on Monday-Friday alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571.272.3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CJB

19 April 2005